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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,922	01/31/2001	Yasuaki Ikemura	826.1672/JDH	9972
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STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER FISCHETTI, JOSEPH A	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 11/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/772,922

Applicant(s)

IKEMURA ET AL.

Examiner

Joseph A. Fischetti

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 18 is/are pending in the application.
- 4a) Of the above claim(s) 5-9 and 12-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 10, 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

A call was place to Atty. Gollhofer regarding the species requirement remaining in the outstanding election requirement. Election was made without traverse to invention/species of claims 2-4. Claims 5,6,7,8,9/ 12-17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 1/14/05. However Applicant now attempts to recapture the claims which he elected to be withdrawn without traverse. This can not be allowed. At the time the election was made without traverse, claims 5,6,7,8,9 12-17 were withdrawn by operation of law. The proposed amendment to claim 12 does not lessen the burden on the examiner. This is a business method case. Because of this, there are additional search requirements and justifications which must be made in the record for each independent claim, particularly as between method and article. Thus, **by** the mere inclusion of claims 12-16, the burden on the examiner has been increased by two-fold in terms of template requirements. Finally, there are two statutory inventions in question here and each has the potential of covering a different inventive concept.

Claim 18 is withdrawn as drawn to an invention which was not elected in applicant's response to the restriction requirement, nor was it originally presented. It stands as another sub-combination relative to claim 1 in that there is no storage unit recited in the combination of claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,2,3,4,10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO/29578 in view of Manchala.

WO 96/29578 discloses a receiving unit receiving order signal including remainder quantity information that shows a remainder quantity of merchandise (interface 104 receives a signals resulting from comparing projected usage level to actual and a resultant signal which prompts a delivery);

a prediction period calculation unit (system 10 predicts storage tank product levels based on forecasted and actual usage rates, page. 17 lines 18-34)

calculating a period until a remainder quantity of the merchandise is exhausted based on purchase history of a purchaser and the remainder quantity information ("system 10 compares the projected usage level to the actual usage level every predetermined time period" and "the system 10 predicts storage tank product levels based on forecasted and actual usage rates", the system 10 compares the projected usage level to the actual usage level...; [I]f a significant disparity arises, the inventory management system 10 determines whether a low product level will occur..." see, WO 29578 page 17 lines 18-34. Since the system 10 compares projected to actual usage levels of product this difference must by definition include the variable of the time left

because the formula for determining same is a function of time for example usage is defined by gallons/day(actual)- gallons/day(theory). The result is still the function of time period i.e. one day. The exhaust limit is read as the low product level threshold.

However, WO 96/29578 does not disclose an order information preparation unit a shop where the merchandise can be purchased most cheaply, selling price the merchandise, and preparing order information based on the selection with the order unit ordering the merchandise from the selected shop based on the order information. But, Manchala et al. disclose an order preparation unit which selects a supplier based on the cheapest price and calculated period (leeway) (see col. 6 , lines 23-30 vendors A/B selected based upon price). It would be obvious to modify the apparatus 10 in WO '578 to include the best priced vendor feature of Manchala et al. the motivation this would allow for cost savings for the buyer.

Also, Manchala answers the limitation of a shop information acquisition unit acquiring from each of a plurality of shops selling prices of the merchandise (products) for a specified period and recording the selling prices of the merchandise for the specified period by associating the selling prices with shop names and selling dates which apparently is not disclosed WO'578. More specifically, col. 5 lines 55 et seq. identity of each vendor is given a vendor id., col. 6 lines 26 et seq. and in col. 6 lines 26 et seq. other vendors are sought for quotes which inherently would have an id associated with them. The calculated period is read as the period in which the solicitation for quotes was made.

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Notwithstanding, even if the functional language of the claims is not met exactly by the above combination, the combination is nevertheless still fully capable of functioning in the manner set forth by applicant in the claims, given that applicant has failed to assert 112 sixth paragraph meaning in the claim language hence all language following the terms "unit" is deemed to be functional.

Re claim 2: Manchala et al. disclose timing an order e.g. setting a purchase day in col. 6 and when and where the merchandise can be purchased most cheaply, taking into consideration, the calculated period, the order unit places an order with the selected shop so that the merchandise can be purchased on the selected purchase day (one of vendors A/B is selected based upon leeway e.g. calculated period and purchase day is read as the day where the inventory is depleted beyond an allowable level. The cost of delivery as part of a purchase price is old and notorious and official notice is hereby taken thereof. The motivation is again repeated as allowing for cost savings for the buyer.

Re claim 3: Manchala et al. disclose the variation between the price offered by vendors A or B is read as a fluctuation. The motivation for the teaching of Manchala et al. would be to allow for cost savings for the buyer.

Re claim 4: Manchala et al. disclose evaluating current demand which is deemed to be an obvious variant of season change (holiday season vs. regular time) and purchase history. The motivation for the teaching of Manchala et al. would be to allow for cost savings for the buyer.

Re claim 10: col. 6 line 18 in Manchala et al. disclose inventory level which is read as a predetermined quantity. The motivation for the teaching of Manchala et al. would be to allow for cost savings for the buyer.

Re claim 11: WO/96/29578 disclose fluid inventory. The motivation for the teaching of Manchala et al. would be to allow for cost savings for the buyer.

Remarks:

Applicant's reply dated 8/18/05 has been considered but are not persuasive.

First and foremost, applicant has not asserted 112 sixth meaning to the functional language found in the claims. The functional language is read as the as that language following the word "unit" which describes the unit's function. As such, all the examiner needs to show in rejection of these claims is that's the prior art is capable of accomplishing the same function. It is clear that WO 578 discloses a receiving unit read as interface 104; a prediction period calculating unit read as the system 10 as described in page 17, lines 18-34; and that Manchala et al. disclose a shop information acquisition unit read as quote solicitation feature of col. 6 line 26; and an order information unit e.g., vendors A vs. B are compared for best price, col. 6 line 28; and both primary and secondary references disclose order units, e.g., the system administrator in Manchala et al. and the system 10 in WO 578. Because there is no assertion of a 112th meaning of the recitations in these claim elements, the examiner has met the burden of prima facie obviousness by showing that they are capable of accomplishing the recited functions given that each is connected to a component of the system which, even if

applicant challenges the disclosed function as being the same, these elements are still capable of accomplishing the desired claimed result. Even still, even if Applicant had so invoked 112 6th he still has not recited claim elements with sufficient specificity to overcome the art of record, because the combination is proper and the elements of the references meet the functional description of the claims.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication should be directed to Joseph A. Fischetti at telephone number (703) 305-0731.

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JOSEPH A. FISCHETTI
PRIMARY EXAMINER
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